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MAILED

MAR 21 2012

OFFICE OF PETITIONS

In re Patent No. 6,228,074 :
Issued: 05/08/2001 :
Application No. 09/173,422 : REQUEST FOR INFORMATION
Filed: 10/15/1998 :
Atty Docket No. 55855.3 :

This is a decision on the request for reconsideration under 37 CFR 1.378(e), filed on January 19, 2012.

The petition is **dismissed**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. **No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b).** No further fee is due for seeking reconsideration.

The patent issued on May 8, 2001. The first maintenance fee was timely paid. The second maintenance fee could have been paid during the period from May 8 through November 10, 2008, or, with a surcharge, during the period from November 11, 2008, through May 8, 2009. The patent expired at midnight on May 8, 2009, 2005, for failure to timely pay the second maintenance fee.

On November 8, 2011, a petition under 37 CFR 1.378(b) was filed. On November 21, 2011, the petition was dismissed. On January 19, 2011, the present request under 37 CFR 1.378(e) was filed, accompanied by the required fee of \$400.00.

Petitioner stated that responsibility for tracking the due dates for the maintenance fees in this patent originally resided with the law firm of Brown Rudnick Berlack Israels LLP ("Brown Rundnick"). Petitioner's registered patent practitioner, John

Serio, states that he left Brown Rudnick and began to practice with the law firm of Seyfarth Shaw LLP ("Seyfarth Shaw"). Petitioner, inventor Stephen Almeida, states that he wished to continue having attorney Serio handle his patent matters, and sent a request on May 16, 2007, to Brown Rudnick, asking that his patent files be transferred to Seyfarth Shaw.

Petitioner has included a declaration from June E. Kaps, docketing administrator at Seyfarth Shaw. Ms. Kaps stated that she previously was employed as the docket administrator at Brown Rudnick.

Ms. Kaps declaration states, in pertinent part:

21. John Serio, Edwin Colon (of Seyfarth Shaw's Records Department) and I conducted a thorough investigation and found that we did not possess the physical file nor the electronic file associated with the '986 Expired Patent and that the patent was therefore not entered into our docketing system.

22. During the course of our investigation we discovered that the '074 parent patent ("'074 Petition Patent") for the '986 Expired Patent was also not in our physical presence or our electronic docketing system;

23. Upon inquiry to the USPTO PAIR system I discovered that the '074 Petition Patent had also expired for failure to pay maintenance fees. As part of our investigation, we requested the file wrapper for the '074 Petition Patent to see what address the Maintenance Fee Reminder and the Notice of Expiration were sent to; (Attachment E & F);

24. The notice for the '074 Petition Patent was sent to our former firm Brown Rudnick on or about June 8, 2009 (as with the '986 Expired Patent) and a previously sent Maintenance Fee Reminder was sent on or about November 17, 2008. However, neither the reminder nor the notice was forwarded to us, as had been the case of the '986 Expired Patent;

25. As part of our investigation I requested that CPI provide us with a list of the clients that were included in the data dump from Brown Rudnick in 2007;

26. Brown Rudnick case number 21221 was not in the data dump even though the client had requested that their information be transferred (Attachment G);

27. Physical files for Brown Rudnick case number 21221 were also apparently not received at Seyfarth Shaw during the transfer of files in 2007.

Petitioners further included a declaration of Keith Schultz, the Director of Information Services for Brown Rudnick. Mr. Schultz' declaration states, in pertinent part:

5. During the month of May 2007 and thereafter, I was involved in the transfer of files related to attorneys that had left Brown Rudnick to join the firm of Seyfarth Shaw (Seyfarth). I worked in conjunction with Deborah Hopkins and Betty McCorkle of Brown Rudnick and Seyfarth's docketing administrator, June Kaps, regarding the electronic transfer of files to Seyfarth.

7. As part of my responsibilities, I coordinated the transfer of electronic docketing information through our docketing software vendor CPI to facilitate the transfer of docketing information of those clients who requested the transfer of their files to Seyfarth.

8. As a result of these transfer requests, Brown Rudnick transferred the physical files of various clients, these files amounted to the work product of several attorneys over the period of several decades and totaled in excess of 700 hundred active files and several thousand inactive files;

9. As a further result of these transfer requests, Brown Rudnick transferred the electronic files of various clients, these electronic files amounted to the work product of several attorneys over the period of several decades and the respective docketing records for this collective work;

10. As part of this transfer process we received a request from Stephen Almeida, Brown Rudnick client number 21221 (Client), to transfer his physical and electronic files to Seyfarth;

11. Pursuant to this request we made arrangements to have the Client's physical files transferred. We

further made arrangements, in coordination with CPI, to transfer the Client's electronic docket entries on the CPI system to Seyfarth. The transfer of the electronic docket entries apparently only affected a transfer of selected Client files concerning matters 7 and 9 and not all Client matters, as the Client had instructed. During the course of Brown Rudnick's investigation, regarding the circumstances giving rise to the expiration of the Petition Patent, it was determined that the selected electronic files attempted to be transferred, matters 7 and 9, concerned non-patent matters for the Client, which contained no docket information;

12. Despite a diligent investigation, I am unsure why a request for the electronic transfer of docketing information for only selected files was sent to CPI, for the Client. Accordingly, it is submitted that any abandonment of this application was unintentional and unavoidable and it is respectfully requested that this Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent under 37 CFR 1.378 (b) be granted.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".¹ A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."² This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."³ Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.⁴ Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.⁵ However, a

¹ 35 U.S.C. § 41(c)(1).

² Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, 1 L.Ed.2d 209 (1995).

³ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁴ In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

⁵ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent

petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.⁶ In view of In re Patent No. 4,409,763,⁷ this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

This petition does not satisfy the requirement of 37 CFR 1.378(b)(3). The statements presented in the petition fail to satisfy the showing required to establish unavoidable delay within the meaning of 37 CFR 1.378(b).

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable.⁸ 35 U.S.C. § 133 does not require the Director to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.⁹

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.¹⁰ That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the second maintenance fee for this patent.¹¹

and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

⁶ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

⁷ 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

⁸ See Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

⁹ See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992); Ray v. Lehman, supra.

¹⁰ Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

¹¹ Id.

Further, with regard to petitioner's allegation of a docketing error, a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(1) the error was the cause of the delay at issue;

(2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance;

(3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.¹²

An adequate showing requires:

(A) Statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them.

(B) Petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledgers, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.

(C) Petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

The present petition lacks the showing required by (1), (2), and (3) above.

It is noted that the declaration of Mark S. Leonardo, partner at Brown Rudnick, states that Keith Schultz "worked under our file room manager, Deborah Hopkins, who at the time of the Seyfarth

¹² See MPEP 711.03(c) (III) (C) (2).

file transfer was our professional file room manager who was responsible for matters concerning our clients' files." (Paragraph 13 of the Leonardo declaration). Further, the declaration of Keith Schultz states that Ms. Hopkins and Betty McCorkle of Brown Rudnick worked on the transfer of electronic files.

Petitioners have not provided affidavits or statements of facts from Deborah Hopkins and Betty McCorkle setting forth the facts as they know them, and explaining their role in docketing and tracking of the maintenance fee for the subject patent at Brown Rudnick, and their involvement in the transfer of the patent files to Seyfarth Shaw. Furthermore, if Ms. Hopkins and Ms. McCorkle may have knowledge of the docketing error, petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

Additionally, as petitioners state that electronic files were transferred from CPI, petitioners should also provide the above-referenced information for any and all CPI personnel involved.

At present, the showing of record suggests that the subject patent was not docketed for payment of the second maintenance fee at Brown Rudnick, in that no docket records for the subject patent were among those transferred to Seyfarth Shaw. If the patent was never entered into the Brown Rudnick database, it appears it would not have been docketed at Seyfarth Shaw, and therefore would not have been docketed at all for tracking and payment of the second maintenance fee. If this is the case, petitioners must provide a showing that the error which resulted in the failure to docket this patent for payment of the maintenance fees was, in fact, unavoidable.

It is additionally noted that petitioners state that Patent No. 6,595,986 ("the '986 patent") was also among those patents for which responsibility for tracking and payment of the maintenance fees was to be transferred from Brown Rudnick to Seyfarth Shaw, but that this patent was also found not to have been entered into the Seyfarth Shaw database after the transfer. The fact that the subject patent is not the only one that was apparently not docketed suggest that there is a question as to whether these patents may not have been docketed for payment of maintenance fees due to flaws in petitioner's docketing system, rather than a

docketing error on the part of a reliable and trusted employee in the performance of a clerical function.

It is imperative that petitioner provide as complete, thorough, and detailed a showing as is possible that the delay was caused by a docketing error. Any renewed petition must explain the docketing error that resulted in the delay in payment of the maintenance fee, and must provide a showing that (1) the docketing error was the cause of the delay at issue; (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; (3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

As the showing of record does not rise to the level of unavoidable delay, the petition must be dismissed. As petitioner has not shown that he exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.¹³

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

¹³ See note 4, supra.

Telephone inquiries should be directed to the undersigned at 571-272-3231.

A handwritten signature in cursive script, appearing to read "D. Wood", written in dark ink.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions